

Appln No. 09/734,237
Amdt date August 6, 2003
Reply to Office action of February 6, 2003

REMARKS/ARGUMENTS

Claims 1 to 4, 23, 24, and 26, as amended, are pending. Applicant has canceled claims 5 to 22, 25 and 27 to 72 and amended claims 1 to 4, 23, 24 and 26. The amendments find full support in the original specification and claims. No new matter is presented. In view of the above amendments and following remarks, Applicant respectfully requests favorable reconsideration and a timely indication of allowance.

Rejections Under 35 U.S.C. § 112, Second Paragraph

The Examiner rejected claims 1 to 12, 14, 15, 23 to 29 and 47 under 35 U.S.C. § 112, second paragraph, as allegedly indefinite. Applicant respectfully traverses this rejection.

First, the Examiner states that claims 1 to 12, 14, 15, 23 to 25 and 27 to 29 are indefinite for the use of the term "non-naturally occurring polymer of nucleic acids," because it is unclear whether this term is meant to define modified polymers such as PNAs or the nucleic acid sequences which are not found in nature. The term is intended to cover "non-naturally occurring polymer[s] of nucleic acids," those not found in nature. Applicant respectfully submits that this terminology is sufficiently definite.

The Examiner states that claims 23 to 26 are drawn to non-elected SEQ ID numbers as well as elected SEQ ID numbers. Applicant has amended these claims to obviate this rejection.

The Examiner states that claim 47 is indefinite for reciting "wherein the predicted free energy of folding per base is greater than that of the second nucleic acid sequence." Applicant respectfully disagrees, but has canceled this claim, thereby obviating this rejection.

Applicant respectfully requests that the rejection under 35 U.S.C. § 112, second paragraph, be withdrawn.

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Rejections Under 35 U.S.C. § 112, First Paragraph

The Examiner rejected claims 1 to 10, 27 to 31 and 44 to 49 under 35 U.S.C. § 112, first paragraph, as allegedly not finding adequate written description support in the specification. Applicant has amended claim 1 to recite sequence of the are at least 90% homologous to the sequences of SEQ. ID NO. 77, SEQ. ID NO. 78 and SEQ. ID. NO. 79. The application provides express written description support for the sequences of SEQ. ID NO. 77, SEQ. ID NO. 78 and SEQ. ID. NO. 79. One skilled in the art would recognize that Applicant was in possession of the claimed genus based on the representative species provided in the specification. Applicant respectfully submits that claim 1 finds adequate written description support in the specification.

Additionally, the Examiner contends that claims 30 to 33, 35 and 36 are not enabled. Applicant has canceled these claims, thereby obviating this ground of the rejection.

Applicant therefore respectfully requests that the rejections under section 112, first paragraph, be withdrawn.

Rejection Under Section 102(e)

The Examiner rejected claims 1 to 12, 14, 15, 27 to 3, 35, 36 and 44 to 49 under 35 U.S.C. § 102(e) as allegedly anticipated by Delagrave et al. (US2001/0051369 A1). Applicant respectfully traverses this rejection. Applicant has amended claim 1 to recite the elected sequences that were originally recited in claims 23 to 26 and homologs thereof. The Examiner has implicitly acknowledged that such sequences are not anticipated by Delagrave. Accordingly, Applicant respectfully requests that the rejection over Delagrave be withdrawn.

Rejection Under Section 103(a)

The Examiner rejected claims 1 to 10, 27 to 31 and 44 to 49 under 35 U.S.C. § 103(a) as allegedly unpatentable over SantaLucia (Proc. Natl. Acad. Sci.). Applicant

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respectfully traverses this rejection. Applicant has amended claim 1 to recite the elected sequences that were originally recited in claims 23 to 26 and homologs thereof. The Examiner has implicitly acknowledged that such sequences are not taught or suggested by SantaLucia. Accordingly, Applicant respectfully requests that the rejection over SantaLucia be withdrawn.

Conclusion

In view of the foregoing amendments and remarks, Applicant respectfully submits that pending claims 1 to 4, 23, 24 and 26, as amended, are in condition for allowance, and a timely indication of allowance is respectfully requested. If there are any remaining issues that can be addressed by telephone, Applicant invites the Examiner to contact the undersigned at the number indicated below.

Respectfully submitted,

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